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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,698	03/18/2004	Michael E. Miller	65937-0047	6051
10291	7590	02/28/2006	EXAMINER	
RADER, FISHMAN & GRAUER PLLC 39533 WOODWARD AVENUE SUITE 140 BLOOMFIELD HILLS, MI 48304-0610			ROY, ANURADHA	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/803,698	<b>Applicant(s)</b> MILLER ET AL.	
	<b>Examiner</b> Anuradha Roy	<b>Art Unit</b> 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/30/04 &amp; 3/18/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Voila et al. (US Patent No. 6,554,779).

Regarding claims 1, 9, & 25, Voila et al. discloses a biopsy system having a biopsy device (22) supported by an adapter (68 & 24), the biopsy device including a handpiece (68) and a cutting element (34) having an outer cannula hub (38) removably mounted to the handpiece, the cutting element including an outer cannula (36) connected to the outer cannula hub and defining a tissue receiving opening (124) and an inner cannula (34) disposed within the outer cannula and attached to the handpiece, the outer cannula hub allowing removal of the handpiece and inner cannula from the outer cannula (Column 4, lines 56-62), the adapter comprising: a base (64); a cradle (44 & 68) moveably mounted to the base and configured to rotatably support the biopsy device therein, the cradle configured to inhibit axial movement of the biopsy device relative to the cradle when locked therein (Column 7, lines 6-21); an indexing guide (74) moveable with the cradle and including a receptacle (distal end of 74) within which the outer

cannula hub is rotatably received (Figure 3, 38 extending to 28), the indexing guide configured to inhibit rotation and axial movement of the outer cannula hub and outer cannula relative to the indexing guide and the cradle when the outer cannula hub is locked therein (Column 8, lines 48-68 & Column 9, lines 1-6).

With regard to claims 2, 10, & 26, Viola et al. discloses a system, wherein the indexing guide includes at least one guide lock (76) that is selectively engagable with the outer cannula hub to inhibit rotation and axial movement thereof (Column 6, lines 22-36).

In regards to claims 3 & 11, Viola et al. discloses a system, wherein the indexing guide includes two guide locks (Figure 3, 76).

Regarding claims 4 & 12, Viola et al. discloses a system, wherein the guide lock is moveably secured to the indexing guide (Figure 3, 68, 74, 76).

In regards to claims 5 & 13, Viola et al. discloses a system, wherein the outer cannula hub includes at least one notch (between 74 & 76) and the guide lock is configured to be received in the notch to prevent movement of the outer cannula hub in a first axial direction (Figure 3).

Regarding claims 6 & 14, Viola et al. discloses a system, wherein the indexing guide includes a lip (distal end of 74) adjacent the receptacle to prevent movement of the outer cannula hub in a second axial direction.

Regarding claims 7 & 15, Viola et al. discloses a system, wherein the cradle includes a pivotable clamp (110 & 112) that is selectively engagable with the handpiece to inhibit rotation and axial movement thereof (Column 7, lines 6-22).

Regarding claims 8 & 16, Viola et al. discloses a system, wherein the adapter includes a deployment mechanism (Column 6, lines 37-45) configured to move the cradle relative to the base.

In regards to claims 17 & 21, Viola et al. discloses a system, wherein cradle provides for rotational positioning of the tissue receiving opening (Column 8, lines 48-59).

With regard to claims 18, 19, 20, 22, 23, 24, 27, 28 & 29, Viola et al. discloses a clamp selectively positionable to stabilize the biopsy device during a medical procedure, selectively positionable to allow or inhibit movement of the biopsy device, and engages an outer surface (22) of the biopsy device to inhibit rotation (Column 7, lines 6-22).

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ranalleta (US Patent No. 5,243,994), Kanner (US Patent No. 5,306,260), Schramm et al. (US Patent No. 5,507,298), Huitema et al (US Patent No. 6,007,497), Bauer (US Patent No. 6,120,463), Viola et al. (US Patent No. 6,193,673), & Worm et al. (US Patent No. 6,551,253) all disclose biopsy devices with adapters.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anuradha Roy whose telephone number is (571) 272-

6169 and whose email address is anuradha.roy@uspto.gov. The examiner can normally be reached between 8:00am and 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

~AR~

  
MAX F. HINDENBURG  
SENIOR PATENT EXAMINER  
ART UNIT 3736